

Walz (U.S. Patent No. 5,501,393) and further in view of Coats et al. (U.S. Patent No. 5,624,069).

By the present response, Applicant submits that the remarks and arguments below overcome the rejection by the Patent Office and places the application in condition for allowance.

Applicant notes with appreciation that the Patent Office indicated that Claims 1-16 and 21 are in allowable form. Notice to that effect is respectfully requested. Further, Applicant notes with appreciation that the Patent Office withdrew the finality of this Office Action as premature in response to the Applicant's Petition under 37 CFR §1.181 filed on February 2, 2004. The Patent Office indicated to Applicant's Attorney during a telephone interview on March 4, 2004 that the Patent Office erroneously made the first rejection of Claim 22 in this Office Action a Final Rejection and withdrew the finality of the rejection of Claim 22 in this Office Action as premature.

With respect to the rejection of Claim 22 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Walz* and further in view of Coats et al., Applicant submits that this rejection is improper for the reasons that follow.

In the Office Action, the Patent Office alleges:

Main discloses in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forming a transparent compartment to be adhered to a mailpiece (Col. 2 lines 52-59) having an opening (214) wherein the form is capable of entering); a mail form (100, Col. 2, lines 60-67, and Col. 3, lines 1-3) that is removably attached to the backing sheet and further wherein the mailing form is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20); and wherein the mail form has a mailing label section (100), and a non-adhesively attached receipt portion (112).

However, *Main* does not disclose that the receipt is detachably connected to the mailing label section.

Walz discloses in Fig. 1-5, a mailing form (12, and section 84) comprised of a non-adhesive receipt (84), wherein the receipt is removably attached to a backing sheet (14) and is detachably connected (through perforated lines, 24 and 26) to the mailing label (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Main's* mailing form to include a detachably connected receipt portion as taught by *Walz* for the purpose of providing a confirmation notice which can be mailed back to the sender.

However, *Main* and *Walz* do not disclose wherein the backing sheet has a third layer having an auxiliary third label.

Coats et al. disclose in Fig. 1, a backing sheet (11) forming an envelope compartment wherein a third layer (Col. 5, lines 50-56) being an identification label is disposed on the surface of the backing sheet (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Main* and *Walz's* mailing assembly to include a third layer disposed on the backing layer as taught by *Coats et al.* for the

purpose of providing an identification mechanism for the mailing assembly.

However, independent Claim 22 requires a mailing assembly having a mailing form having a mailing label and a receipt card which has no adhesive backing wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label.

Contrary to the assertions of the Patent Office, *Main* merely teaches a packing slip and shipping label for use on a package. The packing slip has a front side having an area where a destination is contained and printed. The shipping label has a top side and a bottom side. The bottom side is adhesively coated and adhered to the packing slip. The shipping label is removed from the back side of the packing slip. The packing slip is folded such that the destination is visible, and the folded packing slip is placed next to the bottom side of the shipping label. The shipping label is affixed to the package via an adhesive coating adhered to the shipping label.

Walz merely teaches a multi-part mailing form which has two superimposed sheets of material, such as paper stock, which are secured together in adhered areas by an adhesive layer between the sheets. The inner face of a lower sheet is

coated with a non-adhesive material in certain areas so that the sheets are not adhered in these areas. Tear lines extend through both sheets allowing sections of the form to be separated from one another. One of the separable sections has imprinted indicia on the outer face of each sheet and includes an adhered area of the form with a return postcard for confirming receipt of a mailed item.

Coats et al. merely teach a shipping envelope assembly which includes first and second envelopes having aligned open sides and connected together by a perforation. Further, the second envelope is smaller and may be folded up to cover part of a first, printed face of the first envelope, and adhesively secured to it. Moreover, the back of the first envelope has alternating strips of pressure sensitive adhesive and release material, and is covered by a plurality of rectangular labels having intermeshing strips of adhesive and release material.

Further, none of *Main*, *Walz* and/or *Coats et al.*, taken singly or in combination, teach or suggest a mailing assembly having a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 22. *Main* merely teaches that "the front side of the packing slip 100 includes a purchase order number 106, freight airbill number 108,

freight charges 110, certain shipper information 112, and shipper remarks 114." (See *Main*, col. 2, lines 25-88.) Further, the Patent Office admits that *Main* does not disclose that the receipt is detachably connected to the mailing label section and further wherein the backing sheet contains an auxiliary label having adhesive. Moreover, *Coats et al.* do not even remotely disclose a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label.

Contrary to the assertions of the Patent Office, *Walz* merely teaches that "the entire lower section 84 of the form below perforated line 20 comprises a return postcard of the type which is attached to an item to be mailed until received by the addressee, and then returned to the sender as confirmation of receipt." (See *Walz*, col. 4, lines 7-11.) Further, *Walz* teaches that "the upper sheet 12 and the lower sheet 14 have an adhesive layer 16 between them for adhering the upper sheet to the lower sheet in certain areas." (See *Walz*, col. 2, lines 58-60.) Still further, *Walz* teaches that "the front sheet and rear sheet are only adhered together in the return postcard part of the form in the region between tear lines 24 and 26." (See *Walz*, col. 4, lines 42-45.) Clearly, therefore, none of *Main*, *Walz* and/or *Coats et al.*,

taken singly or in combination, teach or suggest a mailing assembly having a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 22.

Moreover, one of ordinary skill in the art would never have been motivated to combine *Main* and *Walz* with *Coats et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. In fact, the Patent Office completely failed to establish a *prima facie* case of obviousness in rejecting Claim 22 under 35 U.S.C. §103(a) as being unpatentable in view of the combination of *Main*, *Walz* and *Coats et al.* No such teaching, suggestion or incentive exists in *Main*, *Walz* and *Coats et al.* to combine *Main* and *Walz* with *Coats et al.* Therefore, one of ordinary skill in the art would not have been motivated to combine *Main* and *Walz* with *Coats et al.*.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not

all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Applicant submits that the Patent Office has merely located components of Applicant's claimed invention. However, that the art disclosed components of Applicant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in *Main*, *Walz* or *Coats et al.* to provide the features set forth in Applicant's invention. Therefore, one of ordinary skill in the art would not have been motivated to combine *Main*, *Walz* and *Coats et al.*

Still further, Applicant submits that the Patent Office is merely "piece-mealing" references together providing various teachings and positively defined limitations of Applicant's mailing assembly to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's

invention is impermissible. Since no suggestion exists to combine *Main*, *Walz* and *Coats et al.*, the Patent Office cannot arbitrarily do so to reject the claim. Instead, a reason is required why one skilled in the art would be motivated to make the proposed combination of primary and secondary references.

In re Nomiya, 184 USPQ 607 (CCPA 1975).

The court in *In re McLaughlin* stated "[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

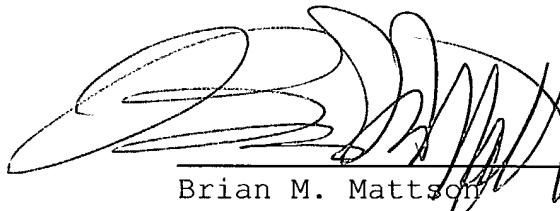
In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 USPQ 2d 1248, 1250 (Fed. Cir. 19789). Since the Patent Office has failed to establish a *prima facie* case of obviousness in combining *Main* and *Walz* with *Coats et al.*, the rejection of Claim 22 under 35 U.S.C. §103(a) is improper.

Applicant respectfully submits that, for the reasons provided above, the rejection of Claim 22 under 35 U.S.C.

§103(a) is improper and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and arguments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

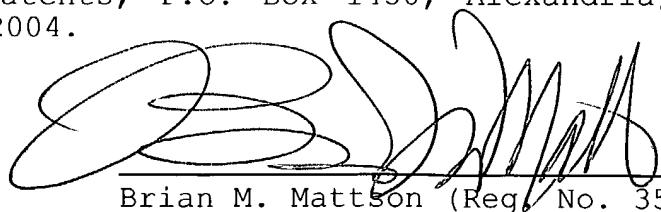


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